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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|--|-------------|----------------------|---------------------|------------------|
| 10/010,390 | 11/05/2001 | Zhong-Min Wei | 21829/111 (EBC-009) | 4469 |
| 7590 06/16/2004 | | | EXAMINER | |
| Michael L. Goldman NIXON PEABODY LLP Clinton Square P.O. Box 31051 Rochester, NY 14603 | | | PARA, ANNETTE H | |
| | | | ART UNIT | PAPER NUMBER |
| | | | 1661 | |
| DATE MAILED: 06/16/2004 | | | | |

Please find below and/or attached an Office communication concerning this application or proceeding.

| | | | |
|------------------------------|------------------------|---------------------|--|
| Office Action Summary | Application No. | Applicant(s) | |
| | 10/010,390 | WEI ET AL. | |
| | Examiner | Art Unit | |
| | Annette H. Para | 1661 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 08 March 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-7, 18-23, 25-41, 75-85, 89-99 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 25-41, 89 and 91 is/are allowed.
- 6) ☒ Claim(s) 1-5, 7, 18-22, 75-79, 81-85, 90 and 93-99 is/are rejected.
- 7) ☒ Claim(s) 6, 18, 23, 80 and 98 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

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DETAILED ACTION

The amendment of March 8 2004 has been received and entered.

Claim objection

Claims 18 and 98 are objected for the misspelling of the recitation "at lease".

Double Patenting

Claims 1-5, 7 and claims 75-79, are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1- 2, 5, 8, 11, 13, 15, 17, 19, of US Patent No. 5, 776, 889. Applicants' arguments filed on March 8, 2004 have been fully considered but are not persuasive. Applicants argue that the taking of a cutting from a floriculture crop plant is an option and that Wei method only taught imparting disease resistance thus these claims are not inherently anticipated by Wei I in combination with Laurie. Applicant also argues that the desiccation resistance and flower longevity were not known in the prior art. The same treatment was applied to plant in both the present application and the prior art. If the plant cutting of the present application after treatment is desiccation resistant, then a cutting of the plant from the prior art, which received the same treatment, is inherently desiccation resistant absent evidence to the contrary.

An inherent structure, composition, or function is not necessarily known. See, e.g., *In re King*, 801 F.2d at 1327; *Titanium Metals*, 778 F.2d at 782... Insufficient prior understanding of the inherent properties of a known composition does not defeat a finding of anticipation. The claimed methods cannot be practiced without infringing the patented claims.

Claims 1-5, 7 remain provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-20 of copending Application No.09/835,684.

Although the conflicting claims are not identical, they are not patentably distinct from each other because

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claims 1-5, 7-12, of the instant application contain the metes and bounds of claims 1-20 of copending application No. 09/835,684.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented. Applicants' willingness to file a terminal disclaimer if necessary is noted.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-5, 7, 18-22, 75-79, 97-99 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wei et al. US Patent 5,776,889 in view of Laurie et al.

Applicants argue that claim of Wei I fails to teach or suggest the result of the presently claims especially the step to expose the cutting to "conditions that would cause desiccation". Wei et al teach the application of an elicitor protein to an ornamental plant. Unless applicant can prove the opposite this ornamental plant is inherently desiccation resistant as the plant of the present application. The step of exposing the removed cutting to condition that would cause desiccation is taught by Laurie. Laurie taught the cutting of flowers. Removal of a cutting from a plant is desiccation stress. Wei et al. In view of Laurie et al. taught every step of the present application's claims. When referring to "this method" (paper number 12152003, page 3) examiner meant the method of imparting disease resistance. When combining the references a disease resistant cutting is obtained.

The applicants then argue that to establish that a reference inherently anticipates a claim it must be demonstrated that the reference necessarily functions in accordance with the limitations of a claim. The specification asserts that it does. Under what conditions does one get resistance to disease but not to desiccation? Applicants argue that taking a cutting from the crop plant only occurs occasionally so the

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results are not inherent. The result is not an occasional result because the desiccation tolerance happens every time a cutting is taken. Applicants argue that new uses of known processes are patentable. However, the claimed process here is not directed to a new use; it is the same use, and it consists of the same steps as taught by Wei. The only step not taught by Wei is taking the cutting, which ~~it would be obvious~~ would be obvious. Newly discovered results of known processes directed to the same purpose are not patentable because such results are inherent. The purpose of the process is the same and can be defined as plant protection process. (see MPEP 2111.02). As stated above the only process step not taught by Wei is taking the cutting but this step would have been obvious when combining the references. Applicants finally argue that it is a well established law that whether a feature is inherent in a prior art reference is irrelevant to the question of obviousness. This statement is erroneous. *In re Napier* 55 F. 3d 610, 613, 34 USPQ2d 1782, 1784 (Fed. Cir. 1995), inherency applies under 103. In this case the inherent teaching of a prior art reference arises both in the context of anticipation and obviousness. It would have been obvious to combine the references to produce a disease resistant cutting. This cutting would have been inherently desiccation resistant as well.

Conclusion

Claims 6, 23, 80 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Claims 25-41 89, and 91 are allowed. Claims 1-5,7, 18-22, 75-79, 81-85 90, 93-99 are rejected.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action

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is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Future Correspondence

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Annette H. Para whose telephone number is (571) 272-0982. The Examiner can normally be reached Monday through Thursday from 5:30 am to 4:00 pm.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Bruce Campell, can be reached on (571) 272-0994. The fax numbers for the group is (703) 872-9306. Any inquiry of a general nature or relating to the status of this application should be directed to the Matrix Customer Service Center whose telephone number is (703) 872-9305.

A.H.P



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SENIOR PATENT EXAMINER
BIOLOGY CENTER 1970